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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,645	06/13/2000	Joseph A. Manico	81254F-P	7582
1333	7590	11/18/2003	EXAMINER	
PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201			HENDERSON, MARK T	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 11/18/2003  
14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/593,645	MANICO ET AL.
	<b>Examiner</b> Mark T Henderson	<b>Art Unit</b> 3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-9,19-34 and 44-47 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9,19-34 and 44-47 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_ .

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**DETAILED ACTION**

**Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 10-28 have been canceled.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-9, 29-33 and 44-47 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum et al in view of Robertson et al (6,293,592).

Applebaum et al discloses in Fig. 4-6, an image product comprising: a first support substrate (34, and a first portion of attachment section (48a) of the hinge 48) having a separate image layer (ink layer which forms the picture); a second support substrate (36, and a second portion or attachment section (48b) of the hinge 48) having a separate image layer (ink layer which forms the picture); the second support substrate secured (by hinge) to the first support substrate to form a dual sided integral composite image product (30, as seen in Fig. 4 and 6, and in Col. 5, lines 25-28); said image product having a plurality hinge lines (G and G') about which the image product may be folded; wherein the substrates are made from a photographic media and paper; a cover (20, as seen in Fig. 4) for holding a hinge leaf (8), and an attaching member (which can be in the form of binding posts (rings), as stated in Col. 3, lines 50-55) to secure the leaf to the cover; and wherein the composite image product comprises a free standing product (Fig. 4).

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Applebaum further discloses that the print can further be made into numerous panels in which they are separated by a fold line (Col. 5, lines 55-65).

However, Applebaum et al does not disclose a fold line per se about which the integral composite may be folded.

Robertson et al discloses in Fig. 3, a first substrate (168 and a first portion of hinge film (164a)), and a second substrate (172 and a second portion of hinge film (164b)), wherein the hinge between the substrates is a hinge/fold line (Col. 3, lines 40-49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applebaum et al's image product with a hinge having a fold line as taught by Robertson et al for the purpose of enabling the folding of the two substrates.

In regards to **Claim 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the first and second support substrate integrally, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Therefore, the first and second support substrates of the Applebaum reference are capable of being a an integral substrate since the image on the face of the substrate is a continuous from one substrate to another.

In regards to **Claims 6 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the substrates and image layer in any desirable material, since it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum et al in view of Robertson et al (6,293,592), and further in view of Douglas (5,815,964).

Applebaum et al as modified by Robertson et al discloses an image product comprising all the elements as claimed in Claims 1 and 2, and as set forth above. However, Applebaum et al and Robertson et al do not disclose wherein the image product allows for a Z-type fold.

Douglas discloses in Fig. 1 an 2, an image product (10) comprising a plurality of fold lines (14 and 16) for providing a Z-type fold in the image product.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applebaum et al's and Robertson et al's image product to include a Z-type fold as taught by Douglas for the purpose of folding multiple panels in a compact position.

4. Claim 34 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Applebaum et al in view of Robertson et al and further in view Hansen

Applebaum et al as modified by Robertson et al discloses an image product comprising all the elements as disclosed in Claims 29-33, and as set forth above. However, Applebaum et al

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does not disclose a scored line on the leaf with the opening allowing the leaf to be installed in a binding attachment.

Hansen discloses in Fig. 1, an image product leaf (wherein the image product consist of the final product of the support substrate (10) and the image layer document (not shown) placed on the support substrate) having scored lines (11) with the opening.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applebaum et al's and Robertson et al's image product leaf to include scored lines with the opening as taught by Hansen for the purpose of assisting with the removal of the leaf.

#### *Response to Arguments*

5. Applicant's arguments filed on September 2, 2003 have been fully considered but they are not persuasive.

In regards to applicant's argument's that the Applebaum et al reference does not depict an "integral composite image product" and that the reference does not further teach a "fold line" as a means to fold the image product, the examiner submits that Applebaum et al discloses separate image product substrates connected by a hinge as a means of folding. The Robertson et al reference is only cited to disclose a first substrate and a second substrate are separated by a

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hinge/fold line between the substrates as indicated above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applebaum et al's image product with a hinge having a fold line as taught by Robertson et al for the purpose of enabling the folding of the two substrates. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the first and second support substrate integrally, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

*Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Therefore, the first and second support substrates of the Applebaum reference are capable of being a an integral substrate since the image on the face of the substrate is a continuous from one substrate to another.

In regards to applicant's argument that the prior art fails to teach "wherein one of the dual sided integral products will be combined to form the cover", the examiner submits that the features upon which applicant relies (i.e., forming of the cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 29, in particular, discloses an attaching member for securing one leaf to the cover. Applebaum et al discloses an attaching member (which can be in the form of binding posts (rings), as stated in Col. 3, lines 50-55) to secure the leaf to the cover.

Therefore, the rejections have been maintained.

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***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 17, 2003



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